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09/960,148

09/20/2001

Jeffrey D. Marsh

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12/22/2003

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EXAMINER

GOODMAN, CHARLES

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 12/22/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/960,148

Applicant(s)

MARSH, JEFFREY D.

Examiner

Charles Goodman

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 September 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2-3 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The Amendment filed on September 22, 2003 has been entered.

### *Election/Restrictions*

2. Applicant's election of Group I, claims 1-41, in Paper No. 6 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse to the extent that no specific arguments were present for reconsideration (MPEP § 818.03(a)).
3. Claims 42-54 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Groups II-V, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6 for the reasons stated *supra*.

### *Specification*

4. The disclosure is objected to because of the following informalities:
  - i. P. 11, l. 23, the phrase "subframe 25" is not clearly understood with respect to the previous line in which reference "27" has been used to designate a "subframe."Appropriate correction is required.
5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is

Art Unit: 3724

requested in correcting any errors of which applicant may become aware in the specification.

### ***Drawings***

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "25" (p. 11, l. 23). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

7. Claim 27 is objected to because of the following informalities: in l. 5, "rimmed" should read -- trimmed --. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 5-9, 11, 14-22, and 30-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3724

- i. The following phrases lack clear antecedent basis: (claim 5) "said one edge of said book resting on said blade",<sup>1</sup> "said first and second minor edges"<sup>2</sup>; (claim 11) "said finished dimensions"; (claim 14) "the face of said blade"; (claim 22) "said one major dimension edge"; (claim 30) "said predetermined finished dimensions"
- ii. Claim 9 is vague and indefinite in that it is not clear what the claim encompasses. It appears to be missing a phrase at the end.
- iii. In claim 31, l. 10, the phrase "retraced position" is not clearly understood. What is "retraced" referring to? Perhaps the term should be -- retracted -- ?

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-3 and 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Westra et al.

Westra et al discloses a document trimming apparatus comprising all the elements claimed including, inter alia, a carriage (e.g. at 106); a holder (e.g. 109). See whole document.

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<sup>1</sup> No "resting" has been set forth.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 4-11 and 14-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Westra et al in view of Cassoni et al.

Westra et al discloses the invention substantially as claimed except that it appears that the shearing plane is not substantially horizontal as claimed. However, Cassoni et al teaches a trimming apparatus in which the books or signatures are trimmed in a substantially horizontal shearing plane. Note Fig. 2. Cassoni et al's teachings suggests that the orientation of the shearing plane, vertical or horizontal, is obvious to the ordinary artisan as a matter of design choice. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the device of Westra et al with the horizontal shearing plane as taught and suggested by Cassoni et al in order to facilitate trimming of the books in a different orientation of the device, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

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<sup>2</sup> No "first and second" minor edges has been set forth, only "minor edges" per se.


**Conclusion**


14. Richards et al, Mohr, Lopez, Aspinwall, and Schneider et al are cited as pertinent art.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Goodman whose telephone number is (703) 308-0501. The examiner can normally be reached on Monday-Thursday between 7:30 AM to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap, can be reached on (703) 308-1082.

In lieu of mailing, it is encouraged that all formal responses be faxed to (703) 872-9306. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-1148.

cg   
December 15, 2003

  
Charles Goodman  
Primary Examiner  
AU 3724  
CHARLES GOODMAN,  
PRIMARY EXAMINER